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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,035	04/11/2001	Henry Ross Perot	074639.0105	1760
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980				
EXAMINER				
DASS, HARISH T				
ART UNIT		PAPER NUMBER		
3692				
NOTIFICATION DATE		DELIVERY MODE		
06/20/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 09/834,035	Applicant(s) PEROT ET AL.
Examiner Harish T. Dass	Art Unit 3692

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See paper # 20080311.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

/Harish T Dass/
Primary Examiner, Art Unit 3692

Continuation of 13. Other: Applicant's arguments filed have been fully considered but they are not persuasive.

The Examiner respectfully disagrees with applicant's remarks, the Examiner has established a prima facie for the claimed limitation, and the proposed claimed limitations are patentable distinguished for disclosed prior art of record.

In response to Applicant's remark (recitation page 15) "The cited references fail to ...", Examiner respectfully disagrees. With broadest reasonable interpretation of the claim, the office action is proper and combination of references (Nieboer-Jaffe- Martin) discloses the process of claimed invention (business method) which is implemented by the analogous system disclosed by primary reference Nieboer (client/server application and form views for inputting orders), with respect to applicant's argument that Nieboer is directed to "electronic system for trading ..." is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Nieboer system is capable to perform the transaction process claimed by the applicant (buying and selling stocks, company, products, etc are economic transactions, unless Examiner is missing something). Nieboer, Jaffe, and Martin disclose known elements (see KSR).

In response to - storing "information on ownership rights in the company relating to the individual". Examiner disagrees with applicant that office action failed to address this limitation. The limitation is for "data storage medium", which is positively claimed. It is well-known that "data storage medium", volatile/non-volatile data storage devices (hard-drives/DVD) is (are) inherent part of the computers/servers, with Examiner's experience database is stored on the hard-drives, where relational database such as Informix, DBII, Oracle, Sybase are capable of storing large amount of information in many related tables and this can be any type of information. Therefore, the database disclosed by primary reference is capable of storing any information such as name of owner of security who trades, account number of trader, social security or tax ID of the traders, type of security, traders addresses/phone number, contract, etc. for any intended use, and storing "information on ownership rights in the company relating to the individual" is patentable distinguished from any other type of information stored on the database.

If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)

In response to "a risk associated with the first form of ownership is limited to a predetermined amount, the predetermined amount being less than an initial investment of the individual in the first form of ownership". Examiner respectfully disagrees. The limitation is for "determine, ..., that the individual is entitled to convert a first form of ownership in company to a second form of ownership". The wherein clause is not give patentable weight because it is descriptive. There is no step following "wherein clause" to claim what will be done in case the amount is higher or equal to predetermine amount to the second form of ownership. However primary reference (Nieboer) disclose inherent risk of the security trading. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the maximum risk (loss) cannot be more than what you paid for the securities, see default setting col. 13 lines 40+, which means the trader can configure his/her default settings including limits, and Cap for reducing risk col. 17 lines 58+ which means limit on loss, and col. 3 conditional order means the order with limit of gain/loss.

In response to "modifying the trading system in Nieboer to implement a customer loyalty program as disclosed by Raphael and/or Jaffe.", since the claimed invention is merely a combination of old elements, and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognized that the results of the combination were predictable (see KSR).

In response to applicant's argument that "allow traders to buy and sell security instruments anonymous.", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to "modifying the trading system in Nieboer to implement a customer loyalty program as disclosed by Raphael and/or Jaffe.", since the claimed invention is merely a combination of old elements, and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognized that the results of the combination were predictable (see KSR).

In response to applicant's remarks regarding "Claims 1-12 and 48-49", Examiner respectfully disagrees, see *Supra*.